

BRIEF AND ADDENDUM FOR APPELLEE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

03-1569
(Serial No. 09/664,247)

IN RE WILHELM ELSNER

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

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STATEMENT OF RELATED CASES

The Director is not aware of any other appeal from the Board of Patent Appeals and Interferences in connection with patent application serial number 09/664,247. The Director does not know of any other cases related to patent application 09/664,247 pending in this or any other court.

However, another appeal pending in this Court, No. 03-1585, *In re Keith W. Zary*, involves similar facts and issues, and may directly affect or be affected by the decision in the present appeal. At the request of both Appellants, the Board of Patent Appeals and Interferences heard the Elsner and Zary appeals in conjunction and decided them concurrently. A5 n.1. We respectfully suggest this Court may wish to do the same.

BRIEF FOR APPELLEE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

03-1569
(Serial No. 09/664,247)

IN RE WILHELM ELSNER

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

STATEMENT OF THE ISSUE

Does substantial evidence support the Board's finding that Elsner's claim to a geranium named 'Pendec' is statutorily barred under 35 U.S.C. § 102(b), given that (i) a publication describing the plant occurred more than one year before the filing date, and (ii) the public had access to the plant through international sales. This case presents a question of first impression for plant patents, *i.e.*, does a printed publication describing the plant, plus the plant's public availability (which enables the printed publication), bar a plant patent applied for over one year later?

STATEMENT OF THE CASE

On September 18, 2000, Wilhelm Elsner (Elsner) applied for a plant patent under 35 U.S.C. § 161. The subject of the claim is a variety of geranium named 'Pendec.' The claim stands rejected under 35 U.S.C. § 102(b) as barred by a printed publication describing the 'Pendec' geranium.

The barring printed publication is a Plant Breeder's Rights application that was announced in print December 15, 1997, more than two and one-half years before this application for a plant patent was filed, and made available to the public. The 'Pendec' geranium itself was made publicly available in Germany beginning in July, 1998, thus enabling the printed publication.

STATEMENT OF THE FACTS

A. The Invention: A Geranium Variety Named 'Pendec.'

The invention is a variety of geranium named 'Pendec.' According to the specification, the 'Pendec' geranium was a spontaneous mutation of a geranium named 'Pendresd.' A77.¹ The 'Pendec' mutant was discovered in France in 1996

¹ Citations to Appellant's brief will be referred to as "Br. at __," citations to the Joint Appendix will be referred to as "A__," and citations to the Director's Addendum will be referred to as "ADN__."

and was asexually reproduced by cuttings later that year in Germany. *Id.* The claim reads:

A new and distinct variety of geranium plant named 'Pendec' as described and illustrated herein.

A32.

B. The Published Plant Breeder's Rights Application.

Elsner filed an application for a Community Plant Variety Rights (CPVR) Certificate/Plant Breeder's Rights (PBR) with the Community Plant Variety Office (CPVO) in Europe for the 'Pendec' geranium on September 3, 1997. A119-36. The application was assigned reference number 97/0950 and was listed on December 15, 1997, in the CPVO Official Gazette. A83.

C. Prosecution Before The Patent Examiner.

The examiner found that the 'Pendec' geranium was cited in the public UPOV database of applications for PBR certificates in the European Community under application number 970950.² A51-52; A59. The examiner determined that the PBR application was a printed publication, and required Elsner to provide a copy of the published application and any information available regarding the sale

² "UPOV" is the French acronym for the International Convention for the Protection of New Varieties of Plants. 35 U.S.C. § 119(g); MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 1612.

or other public distribution of the claimed variety anywhere in the world. A51-53; A57-58. Elsner provided a copy of portions of the CPVO Official Gazette for December 15, 1997, A82-83, and responded that the 'Pendec' geranium was first sold in Germany in July, 1998, and that no sales had been made in the United States before the U.S. application was filed. A64. Elsner also provided a copy of a notice of withdrawal of the PBR application, dated May 21, 1999. A84. Elsner later provided a copy of the PBR application. A119-36.

The patent examiner rejected the claim to 'Pendec' under 35 U.S.C. § 102(b), finding that the PBR application is a printed publication within the meaning of § 102(b). A182-83. The examiner concluded that the PBR application was enabled and placed the skilled artisan in possession of the invention since 'Pendec' was publically available beginning in July, 1998. A180-94.

D. The Board Decision.

The Board of Patent Appeals and Interferences (Board) found that Elsner filed application EU 97/0950 in Europe for a CPVR Certificate/PBR on the 'Pendec' geranium on September 3, 1997. A6. The Board found that the publication date of the PBR application was December 15, 1997. *Id.* The Board also found that Elsner admitted that the 'Pendec' geranium was on sale in Germany in July of 1998. *Id.*

Elsner's current plant patent application was filed in the United States on September 18, 2000, more than one year after the publication of the PBR application. *Id.* The US application date is also more than one year after 'Pendec' was made available in Germany.

According to the Board, "the issue to be resolved is whether the 'description' of the claimed geranium Pendec in EU 97/0950 is sufficient to 'give possession of the invention to the public.'" A8. The Board noted that "Appellant and the examiner agree that no amount of written description of the claimed geranium Pendec would allow one to recreate the plant." *Id.* The Board agreed that the PBR application is a statutory bar to Elsner's plant patent claim since the PBR application gave possession of 'Pendec' to the public more than one year prior to the filing date of this application by way of: (1) public announcement of the existence of 'Pendec' by publication, and (2) the admitted public availability of 'Pendec.' *Id.* The Board concluded that physical possession of the claimed invention is sufficient to meet the enablement test for an anticipating printed publication under § 102(b). A9.

The Board found *In re Samour*, 571 F.2d 559 (CCPA 1978) and *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985) relevant to the issue because they support the proposition that additional evidence may be relied upon to establish that a so-

called primary reference is enabling. A10. The name "Pendec" and the brief taxonomic description of "Pendec" identify the 'Pendec' geranium just as a chemical formula identifies a compound. *Id.* Just as a printed publication giving a most detailed taxonomic description may not describe how to obtain the plant, a printed publication that describes a chemical compound may not describe how to obtain the compound. *Id.* Rather, workers in the respective fields must rely upon publicly available knowledge and their ordinary skill to obtain the compound or the plant. *Id.*

The Board was unpersuaded by Elsner's arguments that *Samour* and *Donahue* were distinguishable. A9. While it may be improbable if not impossible to recreate the 'Pendec' mutant geranium from the original, parent 'Pendresd' geranium, the public is put in possession of 'Pendec' just as assuredly as the chemical compounds in *Samour* and *Donahue* were placed in the public domain, if not more so, by its public availability. A11. Physical possession of a claimed invention, compound or plant resolves any question about whether one can recreate the thing by way of instructions. *Id.*

The Board carefully considered the CCPA's landmark opinion *In re LeGrice*, 301 F.2d 929 (CCPA 1962). A12. The question put squarely to the Board and the CCPA in *LeGrice* was whether a printed publication under § 102(b)

must be enabling in the first instance. *Id.* The *LeGrice* Board decided that a printed publication need not be enabled, and the CCPA reversed. *Id.* In contrast, the question presented in this appeal is how or in what manner a printed publication can be enabling, a question not decided by either tribunal in *LeGrice*. *Id.* The Board here found it significant that the CCPA cast the test for an enabling printed publication under § 102(b) in terms of putting the public in “possession of the invention” instead of using the “make and use” language of § 112. A14.

The Board’s physical possession test is consistent with the manner in which enablement questions have been treated in applications for utility patents involving other living material. *Id.* The Board relied on *In re Argoudelis*, 434 F.2d 1390 (CCPA 1970), in which the CCPA held that a patent applicant could deposit a needed microorganism in a public depository to satisfy the enablement requirement when one “cannot sufficiently disclose by written word how to obtain the microorganism starting material from nature.” A14-15, quoting *Argoudelis*. The Board reasoned that access via a public depository was akin to the access we have here, since ‘Pendec’ was being sold internationally.

The Board concluded that as the printed publication clause of § 102(b) is not limited by location, there was no reason to geographically limit the evidence available for considering enablement of a printed publication. A17. After

considering Elsner's additional arguments concerning, *e.g.*, the description required for the specification in a plant patent, the economic position of foreign plant breeders, freedom to delay filing patent applications, and cost burdens, the Board found them unpersuasive. A17-19. The Board found that domestic and foreign plant breeders face no legal impediment to filing their plant patent applications in the United States within one year of describing their plant in a printed publication and providing access to the plant overseas. A18. A plant breeder's desire for more time to make decisions about commercializing the invention does not create an exception to the statute that applies to all technologies. A18-19. This appeal followed.

SUMMARY OF THE ARGUMENT

The statutory bar provision in Title 35, section 102, exists to prevent withdrawing inventions from the public domain when the public has had possession of the invention for more than one year. The plant claimed here was described in a printed publication more than a year before this application was filed. The same plant was made publicly available by sales in Germany more than a year before this application was filed. Thus, the invention was placed in the public domain more than a year before this application was filed and a patent for the plant is statutorily barred by § 102(b).

Controlling precedent holds that if the public had access to an invention more than one year before a patent application was filed, the claim is anticipated. A printed publication describing a prior art object is enabled if those of skill in the art can obtain the prior art object ready-made or if they can make the prior art object from starting materials. In this case, the prior art printed publication described an object, a plant, that was available ready-made.

Precedent holds that to anticipate a patent claim to a plant, a printed publication describing the plant must be enabling, *i.e.*, it must put the public in possession of the plant. This Court should affirm the Board's holding that a printed publication describing a plant is enabled if public availability allows the public to physically possess the plant. To hold otherwise would frustrate the purposes of the statutory bar.

Policy arguments do not favor an administratively created or judicially created exception to the § 102(b) bar. Precedent expressly dictates that the application of the bar to plant patent claims is the same as for utility patent claims. If the plant industry wants an exception, it may apply to Congress (as it currently has).

The issue in this case, which is essentially the same one presented in Appeal No. 03-1585, *In re Keith W. Zary*, is one of first impression for plant patents. The

question of how a printed publication describing a plant claimed in a plant patent application may be enabled has not been specifically addressed by this Court or its predecessor. Accordingly, we respectfully suggest that the court consider this appeal with Appeal No. 03-1585. This Court may wish to issue a precedential opinion, since this question has not been squarely addressed in prior decisions. In the interest of fully developing the issue, we are providing each Appellant a copy of PTO's red brief for the other case.

ARGUMENT

A. The Standard Of Review.

Whether a publication anticipates a patent application claim is a question of fact. *In re Hyatt*, 211 F.3d 1367, 1371-72 (Fed. Cir. 2000). Whether a publication enabled the invention and placed the public in possession of the invention is a question of law based on underlying factual findings. *Elan Pharmaceuticals, Inc. v. Mayo Found. for Medical Educ. and Res.*, 346 F.3d 1051, 1054-55 (Fed. Cir. 2003); *In re Paulsen*, 30 F.3d 1475, 1481 (Fed. Cir. 1994). This Court upholds the Board's decisions on factual matters if there is substantial evidence in the record to support the Board's findings, and it reviews the Board's legal conclusions *de novo*. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

B. The Purposes of Section 102(b), To (1) Bar Withdrawing Inventions From The Public Domain, And (2) Encourage Prompt Entry Into The Patent System, Would Be Frustrated If Applicants Can Wait As Long As They Wish To File Applications.

“Section 102 of the Patent Act serves as a limiting provision, both excluding ideas that are in the public domain from patent protection and confining the duration of the monopoly to the statutory term.” *Pfaff v. Wells Electronics*, 525 U.S. 55, 64 (1998). Section 102(b) provides:

A person shall be entitled to a patent unless—

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U.S.C. § 102(b).

Simply put, “section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter, or within a year of the time when anyone else may have made it available to the public.” *LeGrice*, 301 F.2d at 936; *In re Bayer*, 568 F.2d 1357, 1361 (CCPA 1978) (“The publication bar of 35 U.S.C. § 102(b) . . . operates upon the theory that the invention in controversy is in the public domain, and once there, is no longer patentable by anyone. The date on which the public actually gained access to the invention by means of the publication is the focus of inquiry”).

Authority is legion that the purpose of the § 102(b) statutory bars is to limit the amount of time an inventor may delay applying for a patent. “As succinctly stated by Learned Hand: ‘[I]t is a condition upon an inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.’ *Metallizing Eng. Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (C.A. 2 1946).” *Pfaff*, 525 U.S. at 64; *see also*, *Seal Flex, Inc. v. Athletic Track and Court Construction*, 98 F.3d 1318, 1322 (Fed. Cir. 1996), *further appeal*, 172 F.3d 836 (Fed. Cir. 1999) (“The law of § 102(b) is an implementation of the policy that if a patent is to be sought it must be applied for within a reasonable time after a completed invention has been placed in commerce”) (overruled on other grounds by *Pfaff*); *Woodland Trust v. Flowertree Nursery Inc.*, 148 F.3d 1368, 1370-71 (Fed Cir. 1998) (“Section 102(b), unlike Section 102(a), is primarily concerned with the policy that encourages an inventor to enter the patent system promptly, while recognizing a one year period of public knowledge or use or commercial exploitation before the patent application must be filed.”); *Ferag AG v. Quipp Inc.*, 45 F.3d 1562, 1566 (Fed. Cir. 1995) (“The underlying policies are what drive[] the section 102(b) analysis Foremost among these is the policy of preventing inventors from exploiting the commercial value of their inventions while deferring

the beginning of the statutory term To this end, the inventor is strictly held to the requirement that he file his patent application within one year of any attempt to commercialize the invention”) (overruled on other grounds by *Pfaff*).

These policies are defeated if inventors may publish their inventions, commercialize them outside the United States, and then patent the invention more than a year after such publication and distribution. The standards applying the statutory bars are the same for plant patents as for utility patents. *LeGrice*, 301 F.2d at 944.

C. Elsner’s Claim Is Barred Because The Public Had Possession Of The Invention More Than One Year Before This Application Was Filed.

1. The Publication Disclosing The ‘Pendec’ Geranium More Than One Year Before The Filing Date Is A Statutory Bar Because The Public Had Access To The Geranium.

Information about the ‘Pendec’ geranium was published in December, 1997, in the Community Plant Variety Office Official Gazette. A6. The geranium became publicly available when it was placed on sale in Germany in July, 1998. *Id.* The public was put in possession of ‘Pendec’ by notice of the geranium and its public availability. A11. That is, the public had actual possession of the invention at least from July, 1998. *Id.* Thus, the geranium was in the public domain more than one

year before the present application was filed in September, 2000. Accordingly, a patent on the geranium is barred under 35 U.S.C. § 102(b).

2. A Printed Publication Of An Invention Is Enabled If The Public Can Possess The Invention By Access To It, Or By Making It.

“[B]efore any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *LeGrice*, 301 F.2d at 936; *Paulsen*, 30 F.3d at 1478-79 (“the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention”).

In situations where the prior art did not provide the invention fully assembled and ready to use, the public’s prior possession has been treated as a question of “constructive” possession. *Id.* That is, the publication is deemed to be enabled if the public could be in possession of the invention without undue experimentation. *Elan Pharmaceuticals*, 346 F.3d at 1054-55. “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” *Id.*, quoting, *Donohue*, 766 F.2d at 533.

Elsner presented no basis to the Board to establish any doubt that those of skill in the art actually possessed the invention, and did not argue that those of ordinary skill could not have made more copies of the publicly available plant.³ Instead, Elsner argued that an anticipating reference must enable the public to recreate or construct the claimed plant from an unmutated parent plant. Br. at 17. While the Board agreed that it is improbable if not impossible to recreate ‘Pendec’ from the parent plant, it found Elsner’s argument misdirected. A11. Elsner is claiming the ‘Pendec’ geranium, not a process for making the ‘Pendec’ geranium. “The date on which the public actually gained access to the invention by means of the publication is the focus of the inquiry.” *Bayer*, 568 F.2d at 1361.

The ‘Pendec’ geranium now claimed is the one described in the PBR application and publicly available from July, 1998. Elsner did not establish that the claimed ‘Pendec’ differs from (1) the ‘Pendec’ described in the PBR application, and (2) the ‘Pendec’ which was publicly available in Germany more than one year

³ Typically, one of skill in the art may reproduce a plant asexually by, for example, taking cuttings. *LeGrice*, 301 F.2d at 937; Br. at 8-9. The apparent ease with which plants were copied was one of the reasons Congress cited when it enacted the Plant Patent Act of 1930 for the benefit of the plant industry: “... nurseries at the time had successfully commercialized asexually reproduced fruit trees and flowers. These plants were regularly copied, draining profits from those who discovered or bred new varieties.” *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 136-37 (2001).)

prior to the filing date of this application. A13. The Board correctly directed its attention to whether the public had “possession of the invention.” A14. *See LeGrice*, 301 F.2d at 936.

By publication and public availability, ‘Pendec’ was in the public domain and was anticipated. “[I]f granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated.” *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003) (quotation omitted). Elsner argues that access to the plant is required for asexual reproduction, Br. at 9, but Elsner disregards the evidence of prior public access to the plant. To disregard the fact that the public had access to the invention, in favor of Elsner’s proposed test that the public must be able to independently invent the plant, would ignore the fact that the geranium was in the public domain, sidestep the § 102(b) possession test, and frustrate the purposes of the statutory bar provision.

3. The Board's Actual Possession Test Is Consistent With Settled Enablement Precedent As Applied in Other Technologies.

a. Utility Inventions Involving Biological Materials Are Enabled When The Inventor Provides For Purchase Of The Invention From A Depository.

As this Court and its predecessor have held when enablement questions have arisen in utility patent applications involving biological materials, the *LeGrice* “possession” test can be met by physical possession of a claimed invention. A14.

For example, *Argoudelis* involved claims to antibiotic compounds produced by a newly discovered microorganism. 434 F.2d at 1392. The microorganism was essential to make the antibiotic, but words could not describe how to obtain the microorganism from nature. *Id.* The CCPA determined that the applicant could deposit the microorganism in a public depository under conditions assuring access by the public to the biological material upon issuance of a patent. Thus, such utility patents are considered enabled, not by the fact that the public can construct or recreate the needed biological material, but by the fact that the public is given possession of the needed biological material upon issuance of the patent. A15.

The practice of depositing biological material arose primarily to satisfy the

enablement requirement of § 112.⁴ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 965 (Fed. Cir. 2002) (“By making the biological material accessible to the public, [applicants] enabled the public to make and use the claimed antibiotics.”). Interested parties can purchase samples of the deposited material from the depository.

An issued patent that relies on a deposit for enablement is available as prior art to later claimed inventions. Its potential to be an anticipating reference is not affected by its failure to teach how to recreate the microorganism because the public possesses the microorganism via the deposit. If the public can obtain a microorganism by means other than deposit, a deposit may not be needed, and again there would be no need to attempt to “recreate” the material from scratch.⁵ A15-16. See 37 C.F.R. § 1.802(b) (“biological material need not be deposited unless access to such material is necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. § 112.”).

⁴ The procedural requirements relating to such deposits are codified at 37 C.F.R. § 1.801-809.

⁵ Plant patent applicants need not make a deposit because there is no enablement requirement for a plant patent. 35 U.S.C. § 162.

**b. When Essential Material Is Made Publicly Available,
Its Geographic Location Is Irrelevant.**

The geographic location of materials or inventions described in printed publications is a matter of convenience, not a statutory requirement. A17. The “printed publication” clause of § 102(b) is not limited by location to “in this country.” Thus there is no reason to geographically limit the evidence available for determining whether a publication is enabled. A17. This is similarly true when assessing the enablement of a utility patent application under § 112, or assessing the enablement of a foreign patent application relied on for priority under § 119.

Where the question of enablement under § 112 has been raised concerning the availability of essential materials in the context of the location of such materials, the geographical location of those materials was irrelevant. Instead, access to the material, whatever its location, is the important question.

Patent claims that required certain microorganisms from a depository in Moscow were enabled because the microorganisms were available to the public under the procedures established by the Budapest Treaty. *Ajinomoto v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1346 (Fed. Cir. 2000). *See also, Feldman v. Aunstrup*, 517 F.2d 1351, 1353 (CCPA 1975) (interference proceeding in which Aunstrup’s enablement was challenged; Aunstrup’s deposit of a microorganism in

a private depository in the Netherlands was sufficient to satisfy enablement and best mode requirements). Similarly, a patent application describing preparing antibiotics from marine organisms available only in ocean waters was found enabling in *Ex parte Rinehart*, 10 U.S.P.Q.2d 1719, 1720 (Bd. Pat. App. & Inter. 1989) (Rinehart's U.S. patent 4,548,814 identifies the location: ocean locations at depths from 10 to 100 feet off the coasts of Central America).

It would make no sense to hold that although such patents met the enablement requirement of § 112 (*e.g.*, *Feldman* and *Rinehart*), and have been held valid and enforceable (*e.g.*, *Ajinomoto*), they would not be enabled as evidence of prior art because the essential biological materials they describe are located outside the U.S.⁶ For these same reasons, Elsner's arguments about the foreign location of the publicly available 'Pendec' geranium are unpersuasive.

The foreign location of the publicly available geranium plants does not mean the public did not have access to or possession of 'Pendec' as described in the published PBR application. The Board correctly found that Elsner's own activities created the bar. A19. There is no sound reason to exclude evidence of public availability from consideration in evaluating the possession test for purposes of

⁶ More than two dozen depositories located outside the U.S. meet the Budapest Treaty depository requirements and may be used for patent deposit purposes. See MPEP § 2405 (listing qualifying depositories).

enablement. *Bonito Boats Inc. v. Thunder Craft Boats Inc.*, 489 U.S. 141, 149 (1989) (“Once an inventor has decided to lift the veil of secrecy from his work, he must choose the protection of a federal patent or the dedication of his idea to the public at large.”).

This Court’s predecessor commented that, “since the purpose of [§ 102(b)] has always been to require filing of the application within the prescribed period after the time the public came into possession of the invention, we cannot see that it makes any difference how it came into such possession, whether by a public use, a sale, a single patent or publication, or by combinations of one or more of the foregoing.” *In re Foster*, 343 F.2d 980, 988 (CCPA 1966) (emphasis added). This comment is sound and was noted by the Board. A17 n.5. Moreover, much earlier, Chief Justice Taney wrote:

If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. . . . But if the foreign discovery is not patented, nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them, and places it in their possession.

Gayler v. Wilder, 51 U.S. 477, 497 (1850) (emphasis added).

Here, the publication of the PBR application notified the public of the existence of the 'Pendec' geranium, and the unrestricted sales placed the plant in the public's possession. Those sales enable the PBR application. Where those sales occurred is irrelevant.

c. Elsner's Proposed Enablement Test—Requiring The Public To Repeat His Discovery Process—Is Irrelevant To The Claim In A Plant Patent.

There is no sound reason to displace the established possession test in favor of Elsner's proposed re-creation test requiring "plant breeding," mutation, or other process. All. The law of anticipation does not require that the reference teach specifically what an appellant has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found expressly or inherently in the reference or in a single prior art device.

Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772 (Fed. Cir. 1983), *overruled in part on other grounds* (reverse doctrine of equivalents), *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1125 (Fed. Cir. 1985) (*en banc*). The claim here reads on the publicly available 'Pendec' plant described in the printed publication, not on the plant breeding process that Elsner suggests as the test for possession. Furthermore, Elsner's "make from scratch" test is inconsistent with the controlling precedent on plant patent claim construction. Claim construction is

the first step in any anticipation analysis in order to establish what it is that the prior art must disclose. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F3d 1339, 1346 (Fed. Cir. 2000).

The subject matter of a plant patent claim is the plant itself and its asexually reproduced progeny. 35 U.S.C. § 162; *Imazio Nursery Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1568 (Fed. Cir. 1995). Thus, “for purposes of plant patent infringement, the patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant.” *Id.* at 1569.

“It is necessarily a defense to plant patent infringement that the alleged infringing plant is not an asexual reproduction of the patented plant. Part of this proof could be, thus, that the defendant independently developed the allegedly infringing plant. Asexual reproduction is the key.” *Imazio*, 69 F.3d at 1570 (emphasis added). If independent invention is a defense to infringement, it is illogical for Elsner to argue that the public must independently invent ‘Pendec’ to prove anticipation. The claim does not read on an independently invented plant. An independently invented plant would be something other than what Elsner is claiming.

d. Prior Publications Do Not Have To Enable Reinventing A Wheel If The Wheel Is Already Available.

It has been said that a reference describing an oil refinery need not describe how to make bolts and rivets in order to be enabling. *In re Wiggins*, 488 F.2d 538, 543 (CCPA 1973). Presumably, this is because bolts and rivets are readily obtained or because they could be readily made. That is, the public could possess the necessary materials by obtaining them ready-made. Access could be by any means. If the described invention is available ready-made, the public does not have to re-create the inventor's process to possess the invention. As the Board put it succinctly: "One should not have to reinvent the wheel if the wheel is publicly available." A11.

However, if an assertedly anticipating publication describes an invention that requires a particular material, and there is no evidence that the public has access to the material, the publication may fail to anticipate because it does not enable the invention. For example, where a claimed method required a particular tool and a trade brochure did not enable a suitable tool, summary judgment finding anticipation was reversed because the brochure did not show that one of skill had access to the tool. In "the absence of evidence that one of skill could have made or obtained the tool," there was a question as to whether someone of skill in the art

possessed the invention without undue experimentation. *Helifix*, 208 F.3d at 1348. (emphasis added).

Elsner argues that “potential” for access to ‘Pendec’ is the essence of the Board’s position. Br. at 16. Elsner misconstrues the Board’s point: ‘Pendec’ was publicly available. The Board explained that the public’s possession was “actual,” not potential. A11 (emphasis in original). Unlike *Helifix*, where there was no evidence that the public could have obtained the needed tool, the evidence here is that ‘Pendec’ was publicly available.

Elsner characterizes the Board’s reasoning as a four-step “research trail” leading only to evidence of foreign sales or to potential for access to ‘Pendec.’ Br. at 15-16. Simply reading the PBR application accomplishes the first three steps in Elsner’s research trail: acquiring the name and address of the plant breeder. A123. The final step is to obtain the plant from the breeder, who had admittedly placed it on sale. As explained by the examiner, all the needed information was available to the public at the Community Plant Variety Office. A51-52 (Office action); A182-94 (examiner’s answer); A220-23 (examiner’s rebuttal to reply brief, *citing* Articles 87 and 88, Council Regulation (EC) No. 2100/94 of 27 July 1994 for Community plant variety rights, *see* A225-26, 246-47). Under *Helifix*, Elsner’s burden was to show that the person of skill in the art could not obtain the plant described in the PBR

application. Elsnor simply cannot meet that burden here since it is undisputed the public had access to the exact same plant he now claims.

The Board did not merely find a research trail but relied on precedent to inform its analysis. See A9-11, discussing *Donohue* and *Samour*. The Board correctly explained that actual objects that are publicly available are evidence that must be considered. A10. *Donohue* and *Samour* held that secondary references showing general knowledge in the art may be accepted as evidence that a primary reference was enabled. Thus, when a single publication discloses a claimed invention, the claim is anticipated even though additional references must be relied upon to show the product was in the public's possession because one of ordinary skill in the art could have made or obtained the disclosed product. *E.g.*, *Donohue*, 766 F.2d at 533; *Samour*, 571 F.2d at 560. When access to necessary starting materials to enable a printed publication is disputed, the question is a fact question, to be decided on the basis of the specific facts. *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980). The issue is subject to a shifting burden of proof. *Id.* Here, the Board has established by substantial evidence that those of skill in the art had access to the plant described in the PBR application.

Elsner also argues that since this Court did not consider a research trail in *Helifix*, the Board must be wrong. Br. at 16-17. In *Helifix*, this Court found the

research trail incomplete. The district court had not made findings sufficient to show the public had possession of an essential tool. Accordingly, this Court reversed the district court's summary judgment of anticipation because there was no evidence that the public "could have obtained the needed tool." *Helifix*, 208 F.3d at 1348. Summary judgment was reversed because the district court failed to construct an appropriate "research trail" leading to the public's possession of the needed tool.

The PTO necessarily uses a research approach for examination. Here, by accessing the UPOV database, the patent examiner discovered that the 'Pendec' geranium had been described in Elsner's own published PBR publication. The examiner properly required Elsner to provide more information. "[T]he PTO [may] use its immediately available data sources to identify legitimate questions that need answering, and then to place upon the applicant the burden of finding those answers." *In re Epstein*, 32 F.3d 1559, 1570-71 (Fed. Cir. 1994) (Plager, J., and Cowen, J., concurring); *Star Fruits S.N.C. v. United States of America*, 280 F.Supp.2d 512, 515-16 (E.D. Va. 2003) (examiner may require the production of such information as may be reasonably necessary to properly examine the application). The Board found the relevant public was put on notice of 'Pendec' by the published PBR application. A8. The application disclosed that Elsner was

applicant and included Elsner's contact information. A123. Elsner's burden was to show the publication was not enabling, *e.g.*, by showing the public did not have access to or possession of 'Pendec.' *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003), *citing Sasse*, 629 F.2d at 681 (anticipation question is subject to a shifting burden of proof).

Elsner's reliance on *Baldwin-Southwark Corp. v. Coe*, 133 F.2d 359 (C.A. D.C. 1942), Br. at 17, is likewise misplaced. The court there found that the printed publication, a trade circular describing the Krause scale, failed to anticipate the claimed apparatus because it failed to include all the claimed elements. 133 F.2d at 366. More specifically, the claim required a "pacer hand," but the trade circular did not permit a determination that the prior art Krause scale necessarily had a pacer hand—what appeared to be a pacer hand could have been maximum hand. *Id.* *Baldwin-Southwark* is inapplicable. Here, the prior art 'Pendec' geranium described in EU 97/0950, is necessarily the same plant as the claimed 'Pendec.'

Elsner further argues that to permit a printed publication such as a catalog or magazine to be enabled by a sale outside the United States would be contrary to precedent. Br. at 26. However, Elsner does not cite any precedent supporting his proposition. Precedent supports the Board. In *Ajinomoto* and *Feldman*, this court and its predecessor approved of patents that relied on foreign sources for essential

biological material needed to enable the patent disclosure. Any member of the public wishing to practice the patented method would have to purchase the needed material from the foreign depository.

Whether a particular catalog or magazine listing enables the invention is a question to be settled on the basis of an inquiry into the facts. *E.g.*, *Beckson Marine, Inc. v. NFM, Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) (remanding for reconsideration of anticipation by prior art including a French company's portlight shown in a magazine advertisement); *Jockmus v. Leviton*, 28 F.2d 812, 814 (2nd Cir 1928) (German manufacturer's catalog, printed in French for the French trade, was a printed publication effective to anticipate broad claim construction). For printed publications generally, an applicant may overcome an anticipation rejection by proving the disclosure is not enabled. *E.g.*, *Amgen*, 314 F.3d at 1355. Here, substantial evidence supports the Board's conclusion of enablement.

Sales can be taken into account for assessing enablement. For example, this Court found no error when a district court relied on sales to enable a prior art device described in a printed publication in *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988). Patent claims to the 2920 computer chip were found anticipated by a published specification sheet. Constant argued the spec sheet did not enable use of the chip because it did not describe a

computer program to make the 2920 chip operational. In other words, the spec sheet could not anticipate the chip because the spec sheet was not enabling. The district court rejected the argument and this court affirmed. Separate evidence showed that a kit for programming the 2920 chip was available to the public and on sale before the critical date. Thus, the commercially available kit enabled the public to program and use the 2920 chip. *Id.* The chip was anticipated by the published spec sheet because the public had possession of the chip before the critical date.

When a single publication discloses a product containing all the limitations of the claim, the claim is anticipated even if additional references are needed to show that one of ordinary skill could possess the product. Here, the PBR application describes the same geranium now claimed by Elsner. Although Elsner argues that the PBR description is not precise, Br. at 17, and that the PBR application has gaps in its disclosure, Br. at 19, the Board correctly regarded such arguments as beside the point. A13. Elsner established no difference between the prior art plant described in the published PBR application and the plant now claimed. *Id.* The alleged “gaps” in the PBR description do not establish that the prior art plant is missing claimed elements. The ‘Pendec’ geranium described in the PBR application is necessarily the same ‘Pendec’ geranium now claimed and inherently has every element now claimed. *See, Schering*, 339 F.3d at 1380 (inherency

operates to anticipate entire inventions). As the prior art geranium described and publicly available under the name 'Pendec' is the same 'Pendec' now claimed, the invention was in the public's possession.

D. *LeGrice* Did Not Decide This Issue And Thus *Stare Decisis* Does Not Apply.

According to Elsner, *LeGrice* decided the issue presented here and this Court is thus bound to reverse the Board. Br. at 9-15. Elsner is mistaken. *Stare decisis* applies only to legal issues that were actually decided in a prior action. *Beacon Oil Co. v. O'Leary*, 71 F.3d 391, 395 (Fed. Cir. 1995).

The question of whether an invention's public availability enables a printed description of the invention was not decided in *LeGrice*. Notwithstanding Elsner's repeated claims that commercial activity was in the factual record and considered by the CCPA, evidence of availability such as by sales was not in the record and was not argued. If a prior decision did not confront and decide the same issue, it is not precedent on the question. *Special Devices, Inc. v. OEA, Inc.*, 269 F.3d 1340, 1346 (Fed. Cir. 2001). The Board correctly determined that *LeGrice* did not decide the issue presented now by Elsner's appeal. A12. The question decided in *LeGrice* was whether a printed publication must be enabling at all, not the question of how or in what manner a printed publication can be enabling. *Id.*

LeGrice itself held that “[e]ach case must be decided on its own particular facts in determining whether, in fact, the description in the printed publication is adequate to put the public in possession of the invention.” *LeGrice*, 301 F.2d at 939. Treating *LeGrice* as if it had decided the question presented by Elsner’s appeal would violate *LeGrice*’s “own particular facts” instruction. Further, when precedent does not squarely address an issue, a later court is free to address the issue on the merits. *Brecht v. Abramhamson*, 507 U.S. 619, 631 (1993).

1. The *LeGrice* Court Did Not Consider Evidence Of Public Availability.

The record before the court in *LeGrice* did not involve evidence of prior public availability or sale of the plant. *LeGrice*, 301 F.2d at 931-32. The CCPA plainly stated: “[t]he particular question of law to be here decided is presented on stipulated facts which, insofar as they relate to the issue, are here quoted from the record.” *Id.* at 931. The quotation of the stipulated facts does not include any reference to or evidence of public use or sales. The stipulated facts included only descriptive material for each of two roses (two roses were involved because appeal was heard for two similar plant patent applications together).

For example, the stipulated record included descriptive material for one of the roses named 'Dusky Maiden,' an entry in the National Rose Society Annual of England reading in its entirety:

—Dusky Maiden (Hy. Poly.) raised and exhibited by E. B. LeGrice, North Walsham.—Glowing dark scarlet with dusky velvety sheen. Single blooms carried in large trusses. Size when open 3-in. in diameter. Very fragrant. Vigorous. Foliage dark green and abundant. Bedding. Trial Ground Certificate, 1945. Prune 34.

Id. at 931. In each case, a catalog publication had been referred to in the inventor's oath, but not included in the record. The contents of the catalog publication were stipulated to as follows:

In each case, the prior catalogue publication referred to in the oath includes a color picture of the rose clear enough to establish identity in appearance between the rose illustrated and the applicant's variety, and the catalog publication with the picture establishes that the rose described and illustrated is the variety described and claimed in the application, and the rose so described and illustrated is, in fact, the variety so described and claimed in the application.

Id. at 932.

Although Elsner maintains that *LeGrice* involved sale evidenced by catalogs, the stipulated description of the catalogs does not support that conclusion.

Contrast Br. at 9 ("commercial activity"), Br. at 12 ("compelling evidence of public use or sale"), and Br. at 13 ("all this evidence of sale and/or public use"), with the catalog description quoted immediately above from *LeGrice*, 301 F.2d at 932. The

LeGrice record contained no evidence that those of skill in the art had access to the plant by distribution or sales one year prior to the patent application filing date.

The anticipation question was answered based solely on the printed description in the Rose Society Annual. *LeGrice* cannot be read to prohibit considering evidence of public availability by any means.

2. *LeGrice* Did Not Squarely Address Sales Because The Board Expressly Excluded Any Consideration Of Sales.

According to the *LeGrice* Board, “[t]he single broad issue of the competency of a prior printed publication to bar a plant patent is presented.”

A205. The Board took the view that a reference did not have to enable the invention to anticipate a claim. It listed the authorities in support of its legal position and discounted or distinguished the contrary authorities. A208-10. The Board stated its holding plainly:

Since appellant has admitted that the reference publications in these cases adequately identify the claimed plants it follows from these [precedents] that the appealed claims were properly rejected regardless of the question of sufficiency of the reference disclosures as to how to produce the plants.

A210 (emphasis added).

As evidenced by the split in authorities cited by the Board, this issue had long been unsettled.⁷ The CCPA settled the question and reversed the Board: to anticipate, a reference must “put the public in possession of the invention.” *LeGrice*, 301 F.2d at 939.

The Board dismissed the relevance of sales. A205. Thus, the question presented to the court did not involve any form of sales, use, or plant availability. When *LeGrice* appealed to the CCPA, the CCPA stated the issue presented as follows: “whether as a matter of law, the English publications constitute, within the meaning of 35 U.S.C. § 102(b), a bar to appellant’s right to patents.” *LeGrice*, 301 F.2d at 930. The CCPA opinion treated the question presented without any reference to foreign use or sales. Its conclusion was:

We therefore hold that descriptions in printed publications of new plant varieties, before they may be used as statutory bars under 35 U.S.C. § 102(b), must meet the same standards which must be met before a description in a printed publication becomes a bar in nonplant patent cases.

...

The mere description of the plant is not necessarily an ‘enabling’ disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art

⁷ Donald S. Chisum, 1 *Chisum on Patents* § 3.04[1][a],[b], traces the history of the divergent anticipation standards to two allegedly inconsistent Supreme Court decisions in the 19th century.

to which they pertain, of placing the invention in the possession of those so skilled.

301 F.2d at 944 (emphasis added).

No one argued public availability to the CCPA and the CCPA did not discuss it. The CCPA said nothing about whether a publication, when considered along with public availability of the invention, “plac[es] the invention in the hands of those so skilled.” Thus, *LeGrice* is not *stare decisis* for Elsner’s appeal. *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991) (“When an issue is not argued or is ignored in a decision, such decision is not precedent to be followed in a subsequent case in which the issue arises.”).

E. Policy Arguments Do Not Favor Carving Out An Exception For The Plant Industry.

According to Elsner, time delays needed for testing new plants can often take several years. Br. at 26. It is said the testing delays place the foreign plant breeder at a disadvantage. Br. at 27. Elsner argues that if § 102(b) is applied to plant patents, the foreign plant breeder is cut off from reaping adequate financial reward in the United States. Br. at 28. According to Elsner, the PTO’s application of § 102(b) denies foreign breeders the benefit of the patent system as contemplated by the Plant Patent Act. *Id.*

The Board correctly determined that the statutory bar provision affects applications from domestic and from foreign plant breeders alike. Both domestic and foreign plant breeders must avoid creating statutory bars to their applications. A18. There is no legal impediment to plant breeders, domestic or foreign, filing their plant patent applications within one year of describing their plant in a publication and providing public access to the plant overseas. *Id.* The statutory bars are the same for plant patents as for utility patents. *Id.*, citing *LeGrice*, 301 F.2d at 933.

As the Board also observed, many industries are faced with difficult decisions about commercializing inventions. A19. Cost burdens and economic circumstances are faced by other industries as well. *Id.* No doubt all would like the luxury of delaying decisions, but all must avoid generating statutory bars. *Id.* If applicants can wait as long as they wish to file their patent applications, even after the invention has been placed in the public domain, the purposes of the statutory bars are frustrated.

Elsner's arguments against the Board's "actual" possession test for enablement, if adopted, would mean that the "printed publication" clause of § 102(b) does not apply to plant patents. No plant patent application could ever be barred by anything other than use or sale in the United States. This is

because, given current technology, no printed publication describing a plant is sufficiently enabled by itself. Rather, to be enabling one needs access to the actual plant, which can only be asexually reproduced. As depository sales of hybridomas or microorganisms can enable printed publications describing certain biological materials, so sales of plants can enable printed publications describing asexually reproduced plants.

LeGrice did not go as far as Elsner asserts it does, and *LeGrice* specifically held that utility and plant patents are subject to the same printed publication bars. *LeGrice*, 301 F.3d at 939. The Board correctly rejected Elsner's arguments for an exception from the printed publication clause of § 102(b) for plant patents. A19.

Plant breeders are pursuing this issue in three venues: in this Court, the district court, and Congress. First, this appeal and the related appeal No. 03-1585, *In re Zary*, have been brought through the usual appeal process. Second, a district court challenge was provoked by at least two other plant patent applicants who declined to provide patent examiners with information about prior printed publications and sales. The PTO abandoned both applications for failure to respond to a requirement for information about prior publications and sales. 35 U.S.C. § 133; 37 C.F.R. § 1.105. The applicants sought review under

the Administrative Procedure Act, and the district court determined the PTO's procedures were not arbitrary, capricious, an abuse of discretion, or contrary to law. *Star Fruits*, 280 F.Supp.2d at 517.⁸ Third, a legislative proposal to amend § 162 has been introduced.

F. Congress Is The Forum For Seeking Changes To The § 102(b) Grace Period.

The Board correctly rejected Elsner's demand for an exception from the printed publication clause of § 102(b) for plant patents. A19. As Elsner observes, Congress enacted plant patents in order to afford agriculture "so far as practicable, the same opportunity to participate in the benefits of the patent system as has been given to industry." Br. at 27, *quoting* H.R. 1129, 71st Congress, 2d Session (1930) (emphasis added).

Elsner argues that the PTO has made a radical change in policy. Br. at 29. If the PTO was aware of printed publications and public availability in other cases and nevertheless issued patents, such errors would not create a precedent to be followed. *In re Donaldson*, 16 F.3d 1189, 1194 (Fed. Cir. 1994) ("The fact that the PTO may have failed to adhere to a statutory mandate over an

⁸ The district court's decision has been appealed. The appeal was filed at the Court of Appeals for the Fourth Circuit, which transferred the appeal to this court by order dated December 1, 2003.

extended period of time does not justify its continuing to do so”). However, when the PTO had evidence that unique biological materials were described in print and were available on sale outside the U.S., the PTO has applied the printed publication statutory bar provision. *Ex parte Thomson*, 24 U.S.P.Q.2d 1618 (Bd. Pat. App. & Interf. 1992) (publications describing a cotton plant were enabled by seeds available in New Zealand; Thomson had deposited the same seeds to enable the claim).

Although Elsner argues that a large percentage of plant patents may be invalid if the Board is affirmed, Br. at 29, that is not a sufficient reason to create an exception. If international sales may not be considered when assessing enablement, the validity of utility patents relying on foreign depositories to provide the public with access to essential materials such as hybridomas and microorganisms would be in doubt.

The only difference between applications for plant patents and for utility patents is the relaxed description requirement for plant patents. 35 U.S.C. § 162 (the description need be only “as complete as is reasonably possible”). If the plant industry wants another exception written into the statute, Congress is the appropriate forum to hear the issue. At least one bill in this area was introduced to Congress in 2002, and reintroduced in 2003. Now designated H.R. 242,

“The Plant Breeders Equity Act of 2003” would provide a 10-year grace period for plant patent applications by adding a paragraph to § 162 to read:

No plant patent shall be denied, nor shall any issued plant patent be invalidated, on the grounds that the invention was described in a printed publication to which section 102(b) of this title applies, unless the invention was described in a printed publication in this or a foreign country more than ten years prior to the date of the application for patent in the United States.

ADN1 (emphasis added). Modifying the statute to account for the desires of the plant industry is a policy choice best made by the legislative branch.

If Congress finds that plant testing delays warrant a change, Congress may amend Title 35. Congress did, for example, recognize that regulatory delays for drug approval warranted a statutory mechanism for extending the patent term for certain pharmaceutical patents. It is significant that Congress chose to provide for patent term extension only when certain conditions were met. *See*, 35 U.S.C.

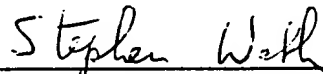
§ 156. That is, Congress did not sweep broadly by cancelling novelty or statutory bar requirements for drugs subject to testing. The Food and Drug Administration (FDA) review periods that delay market entry have no effect on patentability determinations. Instead, when a patent examiner allows an application for a drug patent to issue, the patent might issue before the FDA finishes its independent review. After FDA approval, a Congressionally provided patent term extension

may be available to compensate the inventor for time required by FDA review. To date, Congress has not provided corresponding extensions for plant patents.

CONCLUSION

The PBR application disclosed the claimed 'Pendec' geranium more than one year prior to the filing date, and the public had access to the plant, thus enabling the PBR application. Therefore, the claim is statutorily barred under § 102(b) and the Board's decision should be affirmed.

Respectfully submitted,



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December 30, 2003

*Attorneys for the Director of the
United States Patent and Trademark Office*

ADDENDUM

HR 242 IH

108th CONGRESS

1st Session

H. R. 242

To make technical corrections in patent law.

IN THE HOUSE OF REPRESENTATIVES

January 8, 2003

Mr. ISSA (for himself, Mr. FARR, Mr. NETHERCUTT, and Mr. MEEHAN) introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

To make technical corrections in patent law.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the 'Plant Breeders Equity Act of 2003'.

SEC. 2. AMENDMENTS TO TITLE 35, UNITED STATES CODE.

(a) **HEADING-** The heading of section 162 of title 35, United States Code, is amended to read as follows:

'Sec. 162. Description, claim, novelty'.

(b) **NOVELTY-** Section 162 of title 35, United States Code, is amended by adding at the end the following new paragraph:

'No plant patent application shall be denied, nor shall any issued plant patent be invalidated, on the grounds that the invention was described in a printed publication to which section 102(b) of this title applies, unless the invention was described in a printed publication in this or a foreign country more than ten years prior to the date of the application for patent in the United States.'

(c) **CONFORMING AMENDMENT-** The item relating to section 162 in the table of sections for chapter 15 of title 35, United States Code, is amended to read as follows:

'162. Description, claim, novelty.'

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(d) **EFFECTIVE DATE-** The amendments made by this section shall take effect on the date of the enactment of this Act and shall apply to any application for a plant patent that is filed on or after that date, or is pending on that date, and to any patent in force on that date.

END

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HR 5119 IH

107th CONGRESS

2d Session

H. R. 5119

To make technical corrections in patent law.

IN THE HOUSE OF REPRESENTATIVES

JULY 15, 2002

Mr. ISSA introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

To make technical corrections in patent law.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the 'Plant Breeders Equity Act of 2002'.

SEC. 2. AMENDMENTS TO TITLE 35, UNITED STATES CODE.

(a) **HEADING-** The heading of section 162 of title 35, United States Code, is amended to read as follows:

'Sec. 162. Description, claim, novelty'.

(b) **NOVELTY-** Section 162 of title 35, United States Code, is amended by adding at the end the following new paragraph:

'No plant patent application shall be denied, nor shall any issued plant patent be invalidated, on the grounds that the invention was described in a printed publication to which section 102(b) of this title applies, unless the invention was described in a printed publication in this or a foreign country more than ten years prior to the date of the application for patent in the United States.'

(c) **CONFORMING AMENDMENT-** The item relating to section 162 in the table of sections for chapter 15 of title 35, United States Code, is amended to read as follows:

'162. Description, claim, novelty.'

(d) **EFFECTIVE DATE-** The amendments made by this section shall take effect on the date of the

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enactment of this Act and shall apply to any application for a plant patent that is filed on and after that date, or is pending on that date, and to any patent in force on that date.

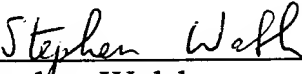
END

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PROOF OF SERVICE

I hereby certify that on this 30th day of December, 2003, I served the foregoing BRIEF AND ADDENDUM FOR APPELLEE, THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE upon counsel by causing two copies to be delivered by FederalExpress, along with a courtesy copy of the Director's brief filed in Appeal No. 03-1585, *In re Zary*, to:

Julie W. Meder, Esq.
THE WEBB LAW FIRM
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219




Stephen Walsh
Associate Solicitor

**Certificate of Compliance With Type-Volume Limitation,
Typeface Requirements, and Type Style Requirements**

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because it contains 9,299 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using the WordPerfect® program in font size 14, and Times New Roman font.

December 30, 2003



Stephen Walsh
Associate Solicitor